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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/520,321

10/27/2005

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CU-6585

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EXAMINER

MCPHERSON, JOHN A

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

04/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/520,321	Applicant(s) TATSUZAWA ET AL.	
	Examiner John A. McPherson	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004 and 27 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-42, 44, 46, 48, 53, 56, 59-62, 65, 66, 69, 70, 73 and 74 is/are allowed.
- 6) ☒ Claim(s) 29-36, 43, 45, 47, 49-52, 54, 55, 57, 58, 63, 64, 67, 68, 71 and 72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 29-33, 51, 54 and 71 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 4 and 5 of U.S. Patent No. 6,826,001. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the present invention claims a green pigment, a photosensitive color composition and a color filter comprising the green pigment, wherein the green pigment is a phthalocyanine green pigment expressing a region of xy-chromaticity coordinate enclosed by equations 1, 2 and 3, the patented invention claims a color filter comprising a zinc phthalocyanine pigment (see claim 2),

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wherein 9 or more halogen atoms among 8 to 16 halogen atoms bonded to the benzene rings in one phthalocyanine molecule are bromine atoms.

It is the position of the Examiner that a zinc phthalocyanine pigment having less than 13 bromines on average per one molecule would inherently have the xy-chromaticity coordinates of the present invention, because xy-chromaticity coordinates are a material-dependent property.

It would have been obvious to one skilled in the requisite art to utilize less than 13 bromides on average per one molecule on a zinc phthalocyanine pigment, thereby arriving at a green pigment having the xy-chromaticity coordinates of the presently claimed invention, because it is claimed that such bromine-substituted zinc phthalocyanine pigments are among those useful in green pixel portions of a color filter.

Specification

2. The abstract of the disclosure is objected to because it is not presented as a single paragraph. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. Claims 49 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 recites the limitation "the yellow pigment " in line 2, and again in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. This rejection could be overcome by correcting the dependency from claim "34" to claim --47--.

Claim 50 recites the limitation "the yellow pigment " in line 2, and again in lines 3-4. There is insufficient antecedent basis for this limitation in the claim. This rejection could be overcome by correcting the dependency from claim "37" to claim --48--.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 29-36, 43, 45, 47, 49, 51, 52, 54, 55, 57, 58, 63, 64, 67, 68, 71 and 72 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 02/067022 [reference B2 of the Information Disclosure Statement filed 5/10/06] (WO '022), utilizing US 6,826,001 (US '001) as an English-language equivalent.

WO '022 discloses a color filter having a green pixel that is characterized in that 8-16 halogen atoms per phthalocyanine molecule are bonded to the benzene rings of a metal halide phthalocyanine pigment, and shows a maximum transmittance of 520-590 nm throughout the entire region of visible light. See the abstract. The halogenated metal phthalocyanine pigment is disclosed as including zinc phthalocyanine, and as a halogenated metal phthalocyanine wherein 9 to 15 bromine atoms are bonded to

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benzene rings in one phthalocyanine. See column 4, lines 50-55; column 6, lines 37-44; column 7, lines 52-60; column 8, lines 23-34; and claims 2 and 5 of US '001, which issued from a national stage application based upon WO '022.

It is the position of the Examiner that a zinc phthalocyanine pigment having less than 13 bromines on average per one molecule would inherently have the xy-chromaticity coordinates of the present invention, because xy-chromaticity coordinates are a material-dependent property.

Additionally, WO '022 discloses that the halogenated metal phthalocyanine pigment preferably has an average pigment size of 0.01 to 0.10 μm (see column 9, lines 47-51 of US '001), is preferably used in combination with various yellow pigments (see column 11, lines 38-58 of US '001), and may be applied in a photocurable composition (see column 12, line 39 to column 14, line 56 of US '001).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

5. Claims 29-36, 43, 45, 47, 49, 51, 52, 54, 55, 57, 58, 63, 64, 67, 68, 71 and 72 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 2003-161828 [reference B3 of the Information Disclosure Statement filed 5/10/06] (JP '828).

JP '828 discloses a color filter having a hardened film layer of a pigment - dispersed resist, wherein the pigment dispersion contains halogenated metal phthalocyanine having specific metal atoms other than copper and yellow pigment. See

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the abstract. Exemplified metal atoms include Zn, and the phthalocyanine has 8-16 halogen atoms substituted on the aromatic ring, preferably 8 or more bromine atoms and 1 or more chlorine atoms, more preferably 12 or more bromine atoms and 2 or more chlorine atoms. See paragraphs [0009], [0010], [0014], [0019]-[0022] and [0049]-[0053] of the computer-generated translation included with this Office Action.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Allowable Subject Matter

6. Claims 37-42, 44, 46, 48, 53, 56, 59-62, 65, 66, 69, 70, 73 and 74 are allowed because in a photosensitive color composition for a color filter comprising a reactive substance involving a curing reaction and a coloring substance including a first green pigment selected from the group consisting of green pigments for a color filter each of which is comprised of a phthalocyanine green pigment capable of expressing a region of xy-chromaticity coordinate enclosed by equations 1, 2 and 3 defined by the XYZ color system of the CIE when the green pigment is solely subjected to colorimetry using a F10 light source, the prior art does not teach or suggest the photosensitive color composition further comprising a second green pigment selected from the group consisting of green pigments for a color filter each of which is comprised of a phthalocyanine green pigment capable of expressing a region of xy-chromaticity

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coordinate enclosed by equations 4, 5 and 6 defined by the XYZ color system of the CIE when the green pigment is solely subjected to colorimetry using a F10 light source.

7. Claim 50 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (571) 272-1386. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John A. McPherson/
Primary Examiner, Art Unit 1795

JAM
4/27/09